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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/998,195	12/03/2001	Chris H. Senanayake	4821-409-999	4449
20582	7590	09/12/2007		
JONES DAY 222 East 41st Street New York, NY 10017-6702			EXAMINER KUMAR, SHAILENDRA	
			ART UNIT	PAPER NUMBER
			1621	
			MAIL DATE	DELIVERY MODE
			09/12/2007	PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary

Application No.

09/998,195

Applicant(s)

SENANAYAKE ET AL.

Examiner

SHAIENDRA -. KUMAR

Art Unit

1621

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 18 June 2007.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 2-6 and 74-78 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 2-6 and 74-78 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date _____.
- 4) ☒ Interview Summary (PTO-413)
Paper No(s)/Mail Date 7/2/07.
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: _____.

DETAILED ACTION

This office action is in response to applicants' communication filed on 6/18/07.

Claims 2-6 and 74-78 are pending in this application.

Claim Rejections - 35 USC § 103

1. Claims 2-6 and 74-78 are rejected under 35 U.S.C. 103(a) as being unpatentable over combined teachings of Jeffrey et al and Housley et al(US 5,047,432).

Instant claims are directed to hydroxylated derivative of sibutramine, which are stereoisomers. Claims 2 and 74 are directed to stereomerically pure derivative and composition, when R1 and R2 are both hydrogen.

Jeffery et al teaches stereoisomers of hydroxylated derivative of sibutramine, similar to claimed herein. See for example, compound 5a, on page 2583, last compound in column 1, on page 2587, and last compound in column 1, on page 2588, wherein it is expressly teaching the stereoisomers of the derivatives. The difference between the reference and herein claimed compounds and composition is that the reference has not made every derivative that is claimed. The difference between the reference and herein claimed compounds is that the reference is not teaching diastereoisomeric compounds and multiple chiral centers.

Housley et al is teaching that structurally similar compounds as claimed herein can exist in different optically active form, when the compounds contain one chiral center, the compounds can exist in two enantiomeric forms. When the compounds contain more than one chiral center, the compounds can exist in diastereoisomeric forms, similar to claimed herein. Even geometric isomeric compounds have been taught. See column 5, lines 48-60. Also see column 7, lines 48-49.

It would have been prima facie obvious to one of ordinary skill in the art at the time the invention was made to modify Jeffrey et al, by including diastereoisomers and multiple chiral centers in the compounds as taught by Housley et al, because the latter

Art Unit: 1621

reference is expressly teaching that diastereoisomers and multiple chiral centers are old in the structurally similar compounds.

Applicants' arguments were fully considered and were not found convincing, especially in view of the newly cited art. Applicants point out to 5a compound on page 2583 of Jeffrey et al and suggests that they disclose cis/trans isomer. However, Housley et al is expressly teaching that these compounds can exist in various stereoisomeric forms.

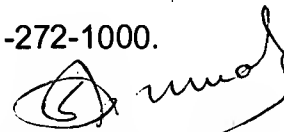
Applicants' submission of two case laws were fully considered, however, claims are still rendered prima facie obvious, especially in view of the newly cited art.

2. Any inquiry concerning this communication or earlier communications from the examiner should be directed to SHAILENDRA -. KUMAR whose telephone number is (571)272-0640. The examiner can normally be reached on Mon-Thur 8:00-5:30, Alt Fri.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Yvonne Eyler can be reached on (571)272-0871. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Art Unit: 1621

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.



SHAIENDRA - KUMAR
Primary Examiner
Art Unit 1621

S.Kumar
9/9/07